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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,808

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Luis Elenes

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EXAMINER

KOHNER, MATTHEW J

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/726,808	ELENES, LUIS	
	Examiner	Art Unit	
	Matthew J. Kohner	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 15-25 and 27 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment / Arguments***

Applicant has cancelled claims 11 and 12 which render moot the drawing objection and the 112 rejection of the previous office action. Applicant has amended claims 1-3, 7, 9, 13, and 15. Applicant has argued the amended claims overcome the rejections of the previous office action. Applicant has traversed the rejection of claim 27 arguing that the proper 112 paragraph 6 analysis was not preformed.

In view of the applicant's response, the claims and prior art are reconsidered. The indicated allowability of claims 13, 15, 16, 19 and 21-25 are withdrawn upon reconsideration of the claim language. Rejections based on the newly cited reference(s) follow.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "a member that extends non-radially from roller" must be shown or the feature(s) canceled from the claim(s). The fingers (82) are interpreted to extend radially from the roller and therefore cannot be the "non-radially extending member". No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

Art Unit: 3653

should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-10, 21-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7 and 21 recites the limitation, a member extending non-radially from the roller. This language is unclear. The fingers shown in the drawings appear to extend radially and therefore cannot be the non-radially extending members. Hence, the claims appear inaccurate.

Therefore, it is unclear what is considered “non-radially extending.” However, given that the specification and drawings allege that the finger protrusion are the members represented by

Art Unit: 3653

the term “non-radially extending” the claims are examined as best understood and the prior art used in the rejections which appears to demonstrate protrusions which are as “non-radially extending” at least as much as can be determined from applicant’s specification’s and drawings’ depiction of “non-radially extending.”

Claim 7 recites the limitation "the roller" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 13, 15-17, 21-23, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,981,496 to Jensen et al. (*hereinafter* “Jensen”).

Jensen discloses a method of processing sheet media comprising:

- moving a sheet medium (7) upward by contact of a face of the sheet medium with a roller (1); and
- carrying a trailing edge with a member that extends non-radially from the roller of the sheet medium upward and then over the roller (see Fig. 4).

In regard to claim 2, Jensen discloses the elements 8 are soft and compressible. Therefore, examiner submits that the elements will deflect (even if only slightly) in a direction opposite to the first direction.

In regard to claims 3, 4 and 5, see Fig. 4.

In regard to claim 13, Jensen discloses a media processing apparatus, comprising

- a rotatable member (see Fig. 4);
- a resilient member (8) connected to the rotatable member and configured to engage a trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member as the rotatable member rotates (see Fig. 4);

wherein the rotatable member is configured to rotate in a direction, and wherein the at least one resilient member is configured to bend opposite to the direction upon contact with a face of the sheet medium (Jensen discloses the elements 8 are soft and compressible. Therefore, Examiner submits that the elements when in contact with the paper will bend (even if only slightly) in a direction opposite to the first direction).

In regard to claim 15, Jensen discloses the elements (8) are compressible into recesses (see Fig.3). Therefore, Examiner submits that the elements, when in contact with the paper's front face of the sheet, will be moved to their retracted position (Fig. 3) and return to the extended position when that contact with the front face is removed (see Fig. 4).

In regard to claim 16, Jensen discloses, in the retracted position, the elements (8) are inside the radius of the roller, while in the extended position the elements are outside the radius of the roller.

In regard to claim 17, see Jensen, Fig 2.

In regard to claim 21, Jensen discloses an apparatus for displacing a sheet of print medium (film) from a direction of movement of the print medium produced by a roller, comprising:

- a body (rotating shaft of roller 1) configured to be connected to the roller for rotation therewith; and
  - at least one resilient finger (8) connected to the body (via the roller 1) and configured to be deflected toward the body (Jensen discloses the elements 8 are compressible into recesses; see Fig.3). Therefore, Examiner submits that the elements when in contact with the paper will deflect towards the rotating shaft), and generally away from the direction of movement, by contact with a face of the print medium to permit movement of the medium along the path and also being configured to engage a trailing edge of the print medium to carry the trailing edge away from the path as the resilient finger rotates,
- wherein the at least one resilient finger extends non-radially from the body.

In regard to claim 22, see col. 2, line 17.

In regard to claim 23, see Fig. 2.

In regard to claim 25, see Fig. 3 wherein the planar distal portion of the finger contacts the face of the sheet media.

Claims 21, 22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 01261161 to Izumi. (*hereinafter* "Izumi").

Art Unit: 3653

In regard to claim 21, Izumi discloses an apparatus for displacing a sheet of print medium from a direction of movement of the print medium produced by a roller, comprising:

- a body (20) configured to be connected to the roller for rotation therewith (see Fig. 3 where the body is connected to the roller for rotation therewith); and
  - at least one resilient finger (20a) connected to the body and configured to be deflected toward the body (Fig. 1 c where 20a is deflected), and generally away from the direction of movement, by contact with a face of the print medium to permit movement of the medium along the path and also being configured to engage a trailing edge of the print medium to carry the trailing edge away from the path as the resilient finger rotates,
- wherein the at least one resilient finger extends non-radially from the body.

In regard to claim 22, see Fig. 1 c where 20a is deformed.

In regard to claim 24, Izumi discloses an apparatus for displacing a sheet of print medium from a direction of movement of the print medium produced by a roller, comprising:

- a body (20) configured to be connected to the roller for rotation therewith (see Fig. 3 where the body is connected to the roller for rotation therewith); and
- at least one resilient finger (20a) connected to the body and configured to be deflected toward the body (Fig. 1 c where 20a is deflected), and generally away from the direction of movement, by contact with a face of the print medium to permit movement of the medium along the path and also being configured to engage a trailing edge of the print medium to carry the trailing edge away from the path as the resilient finger rotates,



wherein the at least one resilient finger includes a proximal portion disposed adjacent the body, and wherein the proximal portion includes a thinned region at which the at least one resilient finger bends upon contact with the face of the print medium to produce deflection.

In regard to claim 25, see Fig. 1.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10, 18-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,681,312 to Harvey (*hereinafter* "Harvey") in view of Jensen.

In regard to claim 6 and 7, Harvey discloses a method comprising:

- placing a colorant on a sheet (col. 1, lines 8 where Harvey discloses a printer)
- moving a sheet medium (1) along an upward path (see Fig. 1).
- carrying a trailing edge of the sheet medium along an arcuate path extending upward.

Harvey does not disclose a protrusion that extends non-radially from the roller. Jensen discloses a protrusion (8) that extends non-radially from the roller. It would have been obvious to one of ordinary skill in the art to modify Harvey to include Jensen's protrusion since Jensen's protrusion would aid in moving the sheet laterally to the stacker (compare Jensen Fig 4 with Harvey Fig. 1).

In regard to claims 8-10, see Jensen, Fig. 4.

In regard to claim 18, Harvey discloses a media processing apparatus, comprising

- a rotatable member (4b);
- a colorant applicant mechanism to apply colorant to the sheet medium.

Harvey does not disclose a resilient member connected to the rotatable member and configured to engage a trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member as the rotatable member rotates. Nor does Harvey disclose that the at least one resilient member is configured to bend opposite to the direction upon contact with a face of the sheet medium.

Jensen discloses a resilient member (8) connected to a rotatable member and configured to engage a trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member as the rotatable member rotates (see Fig. 4). Further, Jensen discloses the at least one resilient member is configured to bend opposite to the direction upon contact with a face of the sheet medium (Jensen discloses the elements 8 are soft and compressible. Therefore, Examiner submits that the elements when in contact with the paper will bend (even if only slightly) in a direction opposite to the first direction.

It would have been obvious to one of ordinary skill in the art to modify Harvey to include Jensen's protrusion since Jensen's protrusion would aid in moving the sheet laterally to the stacker (compare Jensen Fig 4 with Harvey Fig. 1).

In regard to claim 19, see Jensen Fig. 4.

In regard to claim 20 see Fig. 2.

In regard to claim 27, Harvey discloses a printing apparatus comprising:

- means for placing a colorant on a sheet (col. 1, lines 8 where Harvey discloses a printer;

Examiner takes official notice that printers place ink/toner, *etc.* onto paper. Ink, toner, *etc.* is a colorant.).

- means for moving a sheet medium (1) along an upward path (see Fig. 1) by contact of a face of the sheet medium with a roller.

Harvey does not disclose means for lifting a trailing edge of the sheet medium upward and then over the roller. Jensen discloses a protrusion (8) for lifting a trailing edge of a sheet medium upward and then over a roller. It would have been obvious to one of ordinary skill in the art to modify Harvey to include Jensen's protrusion since Jensen's protrusion would aid in moving the sheet laterally to the stacker (compare Jensen Fig 4 with Harvey Fig. 1).

#### **112 paragraph 6 analysis of claim 27**

First, Examiner notes the means + function clause "means for moving a sheet medium along an upward path by contact of a face of the sheet medium with a roller" is an improper "means + function" clause. Under 112 para. 6, "means + function" clauses must not be modified by sufficient structure, material or acts for achieving the specified function. Here, the language "by contact of a face of the sheet medium with a roller" is sufficient structure to make the clause improper. Therefore, the 112 paragraph 6 analysis may only be carried out on the other two mean + function clauses in the claim.

(1) Does the prior art element perform the *same function*?

Art Unit: 3653

a) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers.

b) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device discloses protrusions attached to roller which rotate to move the sheet over the roller to a stacking means

(compare Jensen Fig. 4 with Applicant Fig. 2).

(2) Does the explicit definition provided in the specification exclude the prior art element as an equivalent?

a) means for placing a colorant on a sheet

No.

b) means for lifting a trailing edge of the sheet medium upward and then over the roller

No.

(3) Is the prior art element actually an equivalent of the means plus function?

Factors considered when deciding equivalence

a) prior art element must perform an *identical* function of corresponding element in specification

i) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers which perform the identical function of printing on sheets.

ii) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device discloses protrusions attached to roller which perform the identical function of moving the sheet over the roller to a stacking means (compare Jensen Fig. 4 with Applicant Fig. 2).

b) are there *indicia sufficient* to conclude that one element is or is not an "equivalent" of a different element

i) does prior art element perform *substantially the same function* in *substantially the same way* and produce *substantially the same result* as corresponding element in specification

A) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers which perform the identical function of printing on sheets.

B) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device discloses protrusions attached to roller which perform the identical function of moving the sheet over the roller to a stacking means (compare Jensen Fig. 4 with Applicant Fig. 2).

ii) would a person of ordinary skill in the art have recognized the interchangeableness of the prior art element for the corresponding element in specification

Art Unit: 3653

A) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers which would be interchangeable.

B) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device discloses protrusions attached to roller which perform the identical function of moving the sheet over the roller to a stacking means (compare Jensen Fig. 4 with Applicant Fig. 2) which would be interchangeable.

iii) does the prior art element perform the function in *substantially the same manner* as the function is performed by the corresponding element in specification

A) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers which perform in substantially the same manner.

B) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device perform in substantially the same manner in that they have protrusions, attached to roller, which engage the trailing edge of the sheet and which perform the identical

function of moving the sheet over the roller to a stacking means (compare Jensen Fig. 4 with Applicant Fig. 2).

iv) whether there are insubstantial differences between the prior art element and the corresponding element in specification

A) means for placing a colorant on a sheet

Yes, both Applicant's device and Harvey's device means are printers which have no substantial differences that the examiner can identify.

B) means for lifting a trailing edge of the sheet medium upward and then over the roller

Yes, both Applicant's device and Jensen's device protrusions. Applicant's protrusions are flexible and bend away from direction of travel while Jensen's are soft and compressible and also retract within the roller. However, the differences do not appear substantial, since both devices operate to move the sheets trailing edge upwards to a stacking station and the differences do not take away from the operation.

***Allowable Subject Matter***

Claims 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 571-272-6939. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GENE O. CRAWFORD  
SUPERVISORY PATENT EXAMINER

Matthew J. Kohner  
Examiner  
Art Unit 3653